

## **REMARKS**

Applicant respectfully requests reconsideration of the maintained rejections of the claims of the instant application in view of the following remarks.

### **I. STATUS OF THE CLAIMS**

Claims 20-38 are presently pending and under consideration. Claims 1-19 were previously cancelled, without prejudice. No claims are amended. No claims are cancelled. No new claims are added.

Applicants reserve the right to file a continuation or divisional application on any non-pursued subject matter.

### **II. NONSTATUTORY OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS**

Claims 20-31 and 36-38 have been rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over at least one of U.S. Patent Nos. 6,291,555 ("Surjan et al. '555"; claims 1-19), 6,403,678 ("Surjan et al. '678; claims 1, 2, and 8-10), or 6,420,458 ("Surjan et al. '849; claims 1-12 and 23-26) in view of U.S. Patent Nos. 6,166,849 ("Coleman et al.") and 5,681,128 ("Morgan et al."). In addition, claims 32-35 have been rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over U.S. Patent No. 6,645,340 ("Gienau et al.") and U.S. Patent No. 5,962,602 ("Harman et al.").

Although Applicant does not necessarily agree with the Examiner's conclusions, Applicant will consider filing terminal disclaimers directed to the above-mentioned patents if the claimed subject matter is otherwise allowable. Such terminal disclaimers will render these obviousness-type double patenting rejections moot.

### **III. REJECTIONS UNDER 35 U.S.C. § 103(a)**

Claims 20-31 and 36-38 are patentable over Surjan et al. '555, '678, and '458 and U.S. Patent Nos. 6,402,434 ("Surjan et al. '434") and 6,416,456 ("Surjan et al. '256") in view of Coleman et al. and Morgan et al. Claims 32-35 are patentable over these references as applied to claims 20-31 and 36-38, and further in view of Gienau et al. and Hartman et al. Applicant respectfully submits that the primary references cited,

namely, Surjan et al. '555, '678, '458, '434, and '456, are excluded as prior art under the provisions of 35 U.S.C. § 103(c) for purposes of the instant rejection under 35 U.S.C. § 103(a).

35 U.S.C. § 103(c) provides that “[s]ubject matter [1] developed by another person, which [2] qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where [3] the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Here, the present application is “subject matter developed by another” because, while the inventor Jim Sarjun is listed as a co-inventor of each of the above-referenced patents, the inventive entity is different because not all inventors are the same (i.e., the co-inventors of the cited patents are not co-inventors of the present application). Additionally, the above-mentioned Sarjun et al. patents qualify as art under 35 U.S.C. § 102(e), as acknowledged by the Examiner in the Office Action dated April 2, 2007 (see page 4). With respect to the obligation of assignment, the Patent Office records indicate that the instant application and each of above-mentioned Surjan et al. patents is assigned to the same entity, namely, Illinois Tool Works Inc. Therefore, Applicant respectfully submits that each of the above-mentioned Sarjun et al. patents falls within the provisions of 35 U.S.C. § 103(c) and is thus excluded as prior art because it is subject matter by another, a reference under 35 U.S.C. §102(e), and is commonly assigned.

Claims 20-31 and 36-38 are patentable over Coleman et al., Morgan et al., Gienau et al., Hartman et al., European Patent No. 488,949, Toussaint et al.,<sup>1</sup> U.S. Patent No. 4,623,702 (“Grieves et al.”), and Japanese Patent No. 2000-273354. In the Office Action dated February 11, 2009, the Examiner noted that comparative data has not been submitted to support the finding that the claimed curing agent combination yields unpredictable and superior results over that of the references (see page 4). To this end, Applicant submitted the Rule 132 Declaration filed on August 11, 2009,

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<sup>1</sup> CAPLUS accession no. 1985:596803 for Toussaint et al., Journal of Coating Technology, 1985, vol. 57, no. 728

demonstrating that curable adhesives of the claimed invention unexpectedly have a higher and more consistent anchor pullout strength compared to prior art anchors.

In the outstanding Office Action, the Examiner stated that the data presented is not commensurate in scope with the subject matter claimed. Applicant respectfully submits, however, that the data set forth in the Rule 132 Declaration demonstrates unexpected results at least with respect to the increased pullout strength properties of the inventive compositions, and further that the data presented is meaningful and significant to one skilled in the art. Moreover, Applicant respectfully reasserts that the pending claims are patentable over the cited art for the reasons presented in Applicant's communication dated November 7, 2009. That is, one skilled in the art would not have predicted the increased pullout strength that can be achieved by curing an epoxy adhesive with a curing agent consisting essentially of a plurality of aliphatic amines and at least one tertiary amine.

Applicant submits that the present claims are of a scope reasonably commensurate with the evidence of unexpected results set forth in the Rule 132 Declaration. When considering whether proffered evidence is commensurate in scope with the claimed invention, "Office personnel should not require the applicant to show unexpected results over the entire range of properties possessed by a chemical compound or composition." MPEP § 2145. For example, a narrow portion of a claimed range would be sufficient to rebut a prima facie case of obviousness if one skilled in the art "could ascertain a trend in the exemplified data that would allow him to reasonably extend the probative value thereof." In re Clemens, 622 F.2d 1029, 1036 (CCPA 1980).

Here, one skilled in the art could ascertain a trend in the exemplified data. For example, the Specification provides that a preferred embodiment of the present invention comprises (1) a polymerizable epoxy compound comprising, e.g., about 97% of a liquid bisphenol A epichlorohydrin based epoxy resin (e.g., EPON Resin 828 (phenol, 4,40-(1-methyl-ethylidene) bis polymer with (chloromethyl) oxirane)) and about 3% of a reactive diluent (e.g., 1,4 cyclohexane-dimethanoldiglycidyl ether), and (2) a curing agent comprising aliphatic amines (e.g., Ancamine 1856 and Ancamine 2205) and tertiary amines (e.g., 2,4,6-tri(dimethylaminomethyl)phenol), wherein the amount of curing agent in the composition is preferably about 100 parts by weight and/or by

volume per 100 parts of the polymerizable epoxy compound. See Spec., p. 7, ¶¶ 2-3; p. 10, ¶¶ 2-3. In view of the foregoing, Applicant submits that one skilled in the art in possession of the Specification could ascertain a preferred embodiment of the present inventive composition, and therefore the scope of data presented in the Rule 132 Declaration. In turn, the data presented is reasonably commensurate with the subject matter claimed. Thus, Applicant has fulfilled the burden of establishing that the increased pullout strength of the present invention provides unexpected results not present in the art of record.

Accordingly, Applicant respectfully requests reconsideration and withdrawal the instant rejection.

### **CONCLUSION**

In view of the abovementioned remarks, Applicant respectfully asserts that this application is now in condition for allowance. The Examiner is invited to contact the undersigned counsel in order to further the prosecution of this application in any way.

Respectfully submitted,

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